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Re: **USSN 10/784,459**

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Message:

The following document is attached for filing:

Supplemental Request for Reconsideration and Clarification (6 pages).

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PATENT

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Confirmation No. 8229

Applicants : Allan Charles Webb, et al.
Serial No. : 10/784,459
Filed : February 23, 2004
Title : COMPONENT ASSEMBLY WITH FORMED SPINDLE END PORTION
Group Art Unit : 3682
Examiner : Lenard A. Footland
Attorney Docket No. : 626220510021

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SUPPLEMENTAL REQUEST FOR RECONSIDERATION AND CLARIFICATION

Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Sir:

The Examiner's denial of applicants' right to appeal is contrary to 35 U.S.C. §134, contrary to 37 CFR §41.31, and contrary to the binding decision in *Ex Parte Lemoine*, 46 USPQ 2d 1420 (Bd. Pat. App. & Inter. 1994).

It is going on seven years that the subject matter of the claims under rejection in this application has been pending before the U.S. Patent and Trademark Office. The same claimed subject matter has been rejected on the same grounds in original application Serial No. 09/446,671 filed December 23, 1999, in first continuation application Serial No. 10/195,025 filed July 11, 2002, and in this second continuation application.

CLI-1437029v1

The application actually has been pending for more than nine years because it is based on International Application PCT/GB98/01823 filed June 22, 1998, which in turn is based on British Serial No. 9713343.3 filed June 24, 1997.

Counting the initial and final Office Actions in the two parent applications, and the initial Office Action in this application, claims to the same subject matter have been rejected five times on the same grounds, and the case is ripe for appeal.

The first Office Action in this continuation application is dated October 31, 2005, and rejected claims 61 – 76, 80 and 81 under 35 U.S.C. §112, ¶ 1 & 2, and under 35 U.S.C. §102(e) on U.S. Patent No. 5,490,732 to Hofmann et al.

Applicants appealed the rejection as permitted under 35 U.S.C. §134(a), because claims to the same subject matter in the two parent applications had been finally rejected on the same grounds.

In an Office Action dated June 6, 2006, the Examiner indicated that the appeal was premature because none of applicants' claims had been twice rejected. The Examiner cited 37 CFR §1.111 in support of his position, and held the appeal to be unresponsive to the rejection.

Applicants filed a Request for Reconsideration and Clarification on June 9, 2006, explaining that the claim rejections in the parent applications and in this application satisfy the requirement of twice rejected claims for filing an appeal under 35 U.S.C. §134(a) .

In a telephone conversation with the undersigned, the Examiner has indicated that the Request for Reconsideration and Clarification would be denied because it did not explain how the rejected claims in this application were the same, or similar, or not materially different from, the rejected claims in the parent applications.

It was pointed out to the Examiner, as it was in the original Request for Reconsideration and Clarification, that there is no requirement that the rejected claims in the parent and continuation applications be the same, or similar or not materially different. An argument by the dissent in

Lemoine that the claims had to be of the same scope was rejected by the majority as follows at 46 USPQ 2d 1423:

"The dissent also errs in construing 'any of whose claims has been twice rejected' to mean 'any of whose claims, which do not differ in substance and scope from previously rejected claims, has been twice rejected.' There is simply no support for this limited view in the statute."

"Under our interpretation, so long as the applicant has twice been denied a patent, an appeal may be filed."

The Board in *Lemoine* discussed whether the word "claims" in 35 U.S.C. §134 should be construed as referring to the claims of an application as in 35 U.S.C. §112, ¶2, or in a more general sense to refer to claims for a patent as used in 35 U.S.C. §132. The Board concluded that the word "claims" in 35 U.S.C. §134 is synonymous with a request or demand for a patent as used in 35 U.S.C. §132, and did not mean particular claims of an application. *Lemoine* at 1423.

After reflection and the apparent realization that the appeal is proper under 35 U.S.C. §134 as construed by *Lemoine*, the Examiner telephoned the undersigned to say that *Ex Parte Lemoine* no longer is binding because it was decided in 1994 and is superseded by 37 CFR §41.31 which became effective in 2004. The Examiner further indicated that in his opinion, 37 CFR §41.31 now requires that the claims in the parent and continuation applications must be *identical* to qualify as twice rejected claims under 35 U.S.C. §134.

The Examiner's contentions are disingenuous. *Lemoine* construes 35 U.S.C. §134, and the Examiner's contention that the Patent Office Rule supersedes or overrules the Statute is entirely without merit.

The language in 35 U.S.C. §134 and 37 CFR §41.31 is identical: "any of whose claims has been twice rejected." The words mean the same thing in the Statute and the Rule, and that is the meaning explained by the Board in *Lemoine*.

There is nothing whatsoever in the proposed rulemaking to suggest that 37 CFR §41.31 was intended to attempt a change in the meaning of the statute or the decision in *Lemoine*. See Federal Register, Vol. 68, No. 228, pp 66648 – 66691. On the contrary, page 66649 provides in part:

“Proposed part 41 would better state the existing practice and should not be read to change the existing practice except as explicitly provided.”

The discussion of proposed 37 CFR §41.31 at page 66651 contains no suggestion of any attempt to change the meaning of 35 U.S.C. §134 or to overrule *Lemoine*, and there is no explicit provision in 37 CFR §41.31 that does so. The language of the Rule corresponds to the language of the Statute, as it must. If there were any inconsistencies between the Statute and the Rule, the Statute would control.

A brief history of the claimed subject matter in the three applications is provided here. In parent application Serial No. 09/446,671 filed December 23, 1999, the Final Rejection dated March 14, 2002, rejected claims 81 – 87, 114 and 115 under 35 U.S.C. §112, ¶1&2, and under 35 U.S.C. §102(b) on U.S. Patent No. 5,490,732 to Hofmann et al.

First continuation application Serial No. 10/195,025 was filed on July 11, 2002, to continue prosecution of finally rejected claims 81 – 87, 114 and 115, as well as other claims, and the claims were revised, principally in an effort to overcome the rejection under 35 U.S.C. §112. In a Final Rejection dated July 16, 2003, claims 72 – 74 were rejected under 35 U.S.C. §112, ¶1&2, and under 35 U.S.C. §102(a) on U.S. Patent No. 5,490,732 to Hofmann et al. or U.S. Patent No. 5,603,554 to Monroe et al.

This second continuation application Serial No. 10/784,459 was filed on February 23, 2004, to continue prosecution of finally rejected claims 72 – 74, as well as other claims, and the claims were revised by inserting reference numbers that refer to the drawings, principally in an effort to overcome the rejection under 35 U.S.C. §112. In an Office Action dated October 31, 2005, claims

61 - 76, 80 and 81 were rejected under 35 U.S.C. §112, ¶1&2, and under 35 U.S.C. §102(e) on U.S. Patent No. 5,490,732 to Hofmann et al.

The initial Office Actions dated October 24, 2001, in Serial No. 09/446,671 and February 10, 2003, in Serial No. 10/195,025 also rejected claims to the same subject matter under 35 U.S.C. §112, ¶'s 1 & 2, and under 35 U.S.C. §102(a) and 102(b) on Hofmann et al 5,490,732. Claims to the same subject matter have been rejected on the same grounds a total of five times.

It is inexplicable why the rejection on Hofmann et al. 5,490,732 is sometimes under 35 U.S.C. §102(a), sometimes under 35 U.S.C. §102(b), and sometimes under 35 U.S.C. §102(e), but the rejections are based on the same rationale. Furthermore, 35 U.S.C. §134 and *Lemoine* do not require that the rejections be the same.

While there is no requirement that the claims in the parent and continuation applications not differ in substance and scope for an appeal under 35 U.S.C. §134 and 37 CFR §41.31, the fact is that the claims involved here actually are of essentially the same substance and scope. The rejection of the claims in the three applications on the identical grounds itself suggests that the rejected claims in the three applications do not differ in substance and scope.

Rejected claims 61, 67 and 77 in this application are similar to finally rejected claims 72, 73 and 74 in parent application Serial No. 10/195,025. Rejected claim 61 in this application also is similar to finally rejected claim 114 in Serial No. 09/446,671.

The Examiner's determination that the appeal is premature and not responsive to the Office Action of October 31, 2005, should be withdrawn.

Respectfully submitted,



H. Duane Switzer
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Dated: July 28, 2006

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Confirmation No. 8229

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Dated: July 28, 2006